REMARKS

This is a full and timely response to the outstanding Final Office Action mailed May 31, 2005. In accordance with 37 C.F.R. § 1.114, a Request for Continued Examination is filed concurrently herewith to render non-final the above-referenced Final Office Action. Upon entry of this response, claims 53 - 109 remain pending in the application, and claims 53, 64, 75, 86, 92, 98, 108 and 109 are amended. Applicants respectfully request that the amendments being filed herewith be entered and request that there be reconsideration of all pending claims.

1. Examiner Interview

An in-person interview took place at the United States Patent and Trademark Office on September 16, 2005. The attendees were Examiner Jonathan Ouellette and Applicants' representative, Jeff Kuester. During that interview, the parties discussed 35 U.S.C. § 101 and potential claim amendments that are embodied in the present amendments. Applicants wish to thank Examiner Ouellette for his time.

2. Office Action

In the Office Action, Applicants' claim to priority under 35 U.S.C. § 119 (e) to provisional applications 60/173,919 and 60/192,862 was acknowledged, but adequate support under 35 U.S.C. § 112 for certain claims in their previous form was allegedly not provided by those provisional applications. At this point, Applicants do not address the validity of that conclusion; consequently, Applicants do not intend to express agreement or disagreement therewith.

The Office Action also objected to claims 53, 64, 75, 86, 92, and 98 since Applicants apparently failed to distinctly reference where the specification supports the newly amended/added claims. Applicants submit that examples providing elements of support for the above claims are found on one or more of the following pages of the specification 9 – 17, 46 - 51, 71 – 75, and 177 – 206. Of course, by identifying such support in the present specification, Applicants do not intend to thereby limit the presently pending claims in any matter.

Claims 53 – 63, 75 – 91, 98 – 104, 106, 107 and 109 were also rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. While Applicants do not agree with that rejection, Applicants have nonetheless accordingly amended independent claims 53, 75, 86, and 98 in order to advance prosecution. Claims 108 and 109 were also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Accordingly, Applicants have amended claims 108 and 109 to address the concerns as stated in the Office Action, as well as provide additional cosmetic clarification to the claims.

The Office Action also rejected claims 86, 92, 98 and 107 - 109 under 35 U.S.C. § 102 (e) as being anticipated by Powell (US 2004/0220881 A1). In addition, claims 53, 54, 58, 64, 65, 69, 75, 76, 80, and 104 – 106 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Powell in view of Eggleston (6,061,660). Claims 55 – 57, 59 – 63, 66 – 68, 70 – 74, 77 – 79, and 81 – 85 were rejected under 35 U.S.C. § 103 as being unpatentable over Powell in view of Eggleston. Claims 87 – 91, 93 – 97, and 99 – 103 were rejected under 35 U.S.C. § 103 as being unpatentable over Powell. The Office Action interprets certain claimed elements to be found in the cited references and finds other claim elements to be non-functional descriptive data, allegedly having no ability to distinguish the claims over the cited references.

While Applicants do not agree with such interpretations and conclusions, and further contend that there is no motivation to combine the cited references as stated, Applicants submit that in view of the above amendments, all of the presently pending claims are now in condition for allowance. While Applicants do not admit that the cited references disclose the subject matter as stated in the Office Action, or that certain elements are non-functional descriptive data, Applicants submit that the pending claims are allowable for at least the reason that they all refer to an intellectual property utilization system determining how an intellectual property asset should be utilized based upon intellectual property licensing rights marketability data, wherein the determining includes generating an intellectual property licensing rights marketing opportunity assessment for at least one intellectual property asset corresponding to at least one intellectual property asset protection data record from an intellectual property asset protection database

CONCLUSION

In conclusion, Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims be allowed to issue. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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By: _____

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